

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** DON B. WAFER

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Appeal No. 98-2150  
Application No. 08/539,926<sup>1</sup>

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ON BRIEF

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Before COHEN, MEISTER and McQUADE, ***Administrative Patent Judges.***

MEISTER, ***Administrative Patent Judge.***

DECISION ON APPEAL

Don B. Wafer (the appellant) appeals from the final rejection of claims 1, 8, 17 and 22. Claims 2-7, 9-16, 18-21, 23 and 24, the only other claims present in the application, stand withdrawn from further consideration by the examiner

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<sup>1</sup> Application for patent filed October 6, 1995.

Appeal No. 98-2150  
Application No. 08/539,926

under the provisions of 37 CFR § 1.142(b) as being directed to a nonelected invention.

We AFFIRM-IN-PART.

The appellant's invention pertains to a system for sealing a wellhead that includes a wellhead housing, a wellhead connector and an annularly disposed seal ring. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the appellant's brief.

The reference relied on by the examiner is:

|          |           |          |
|----------|-----------|----------|
| Szymczak | 5,039,140 | Aug. 13, |
| 1991     |           |          |

Claims 1, 8, 17 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Szymczak.

The rejection is explained on pages 2 and 3 of the final rejection. The arguments of the appellant and examiner in support of their respective positions may be found on pages 4-6 of the brief and pages 4-7 of the answer.

**OPINION**

Appeal No. 98-2150  
Application No. 08/539,926

As a preliminary matter, we base our understanding of the appealed subject matter upon the following interpretation of the terminology appearing in the claims. In the last two lines of claim 22 (as they appear in the appendix to the brief) we interpret "said primary sealing surface" to be -- said secondary sealing surface --.

On page 4 of the brief the appellant states that claims 1, 17 and 22 will stand or fall together, but that claim 8 is distinctly patentable. Accordingly, claims 1, 17 and 22 will stand or fall with representative claim 1, while claim 8 will stand or fall by itself. 37 CFR § 1.192(c)(7).

Considering first the rejection of claims 1, 17 and 22 under 35 U.S.C. § 102(b) as being anticipated by Szymczak, we initially observe that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **Verdegaal Bros., Inc. v. Union Oil Co.**, 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject matter of a claim when

Appeal No. 98-2150  
Application No. 08/539,926

that reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. ***RCA Corp. v. Applied Digital Data Systems, Inc.***, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). The law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference. ***Kalman v. Kimberly-Clark Corp.***, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983). Additionally, it is well settled that if a prior art device inherently possesses the capability of functioning in the manner claimed, anticipation exists regardless of whether there was a recognition that it could be used to perform the claimed function. ***See In re Schreiber***, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). ***See also LaBounty Mfg. v. Int'l Trade Comm'n***, 958 F.2d 1066, 1075, 22 USPQ2d 1025, 1032 (Fed. Cir. 1992).

Szymczak discloses a system for sealing a wellhead 12 (which has a primary sealing surface 36 and a secondary sealing surface 38) during two different operating modes. As illustrated in Fig. 1, in Szymczak's first operating mode a

Appeal No. 98-2150  
Application No. 08/539,926

blowout preventer 11 (which has a sealing surface 48) is attached to the wellhead utilizing a seal ring 52 that has a sealing surface 58 (which is in sealing contact with the sealing surface 48 on the blowout preventer) and a sealing surface 60 (which is in sealing contact the primary sealing surface 36 on the well head). The secondary sealing surface 38 on the wellhead is apparently not used during the first operating mode.

As illustrated in Fig. 2, in Szymczak's second operating mode a production tree 66 (which has a sealing surface 80) is attached to the wellhead 11 utilizing a seal ring 86 that has a sealing surface 110 (which is in sealing contact with the sealing surface 80 on the production tree) and a sealing surface 112 (which is in sealing contact with the lower portion of the secondary sealing surface 38 on the wellhead). The primary sealing surface 36 on the wellhead is apparently not used in the second operating mode. The examiner considers that portion of the surface 38 which is not in sealing contact with the sealing surface 112 on seal ring 86 (i.e., the surface between the area of sealing contact of the sealing

surface 112 and the primary sealing surface 36) to be a "reference surface" as set forth in representative claim 1.

In view of the above, it is readily apparent that the system utilized by Szymczak in the second operating mode is readable on the structure recited in representative claim 1. That is, as illustrated in Fig. 2 Szymczak's system comprises a wellhead housing 12, a primary sealing surface 36,<sup>2</sup> a reference surface (that portion of the surface 38 which is not in sealing contact with the sealing surface 112 on seal ring 86), a secondary sealing surface (that portion of the surface 38 that does not have sealing contact with the sealing surface 112 on seal ring 86), a wellhead connector (production tree 66) having a sealing surface 80, a seal ring 86, a ring seal surface 110 for sealing contact with connector sealing surface 80, an extension 100 extending below the ring seal surface 110 and a sealing land 112 disposed on the extension for sealing contact with the secondary sealing surface.

The appellant argues that

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<sup>2</sup> Although the primary sealing surface 36 is not utilized by Szymczak in the second operating mode, there is no requirement in representative claim 1 that the seal ring cooperate with the primary sealing surface.

Szymczak fails to disclose a wellhead housing which includes a reference surface in addition to the primary and secondary sealing surfaces. As discussed above, this reference surface (14) is a cylindrical surface which is used during production of the wellhead housing as a reference for machining both the primary sealing surface (12) and the secondary sealing surface (16 or 18).

Such a separate surface is not disclosed in Szymczak. Rather, Szymczak merely discloses a wellhead housing (12) having a sealing surface (36) which is engaged by the sealing surface (60) of a first seal ring (52) during one mode of his invention, and a sealing surface (38) which is engaged by the sealing surface (112) of another seal ring (84) during another mode of his invention (see column 3, lines 36-45; column 4, lines 17-23). Szymczak does not disclose a separate reference surface from which sealing surfaces (36) and (38) may be machined. [Brief, page 4.]

The appellant's arguments are not commensurate in scope with the subject matter defined by representative claim 1.

As to the appellant's contention that Szymczak does not disclose a reference surface used for machining the primary and secondary sealing surfaces, representative claim 1 merely broadly recites a "reference surface" (without making any reference whatsoever to machining) and, giving this terminology its broadest reasonable interpretation,<sup>3</sup> the

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<sup>3</sup> The terminology in a pending application's claims is to  
(continued...)

reference surface could be for anything (e.g., simply a reference surface that defines an endpoint of the primary sealing surface and/or the secondary sealing surface). Moreover, even if representative claim 1 did recite that the reference surface was used "for machining the primary and secondary sealing surfaces," we must point out that representative claim 1 is directed to a system for sealing, and not to a method of making such a system. Accordingly, such a limitation would merely be a statement of intended use which would not patentably distinguish the subject matter defined by representative claim 1 over the teachings of Szymczak inasmuch as Szymczak's reference surface clearly would have the capability of being used in such a manner. ***See, e.g., In re Schreiber, supra.***

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<sup>3</sup>(...continued)  
be given its broadest reasonable interpretation (***In re Morris***, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997) and ***In re Zletz***, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)) and limitations from a pending application's specification will not be read into the claims (***Sjolund v. Musland***, 847 F.2d 1573, 1581-82, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988)).



Appeal No. 98-2150  
Application No. 08/539,926

As to the appellant's contention that Szymczak does not have a "separate" reference surface, there is simply no limitation in representative claim 1 which would preclude Szymczak's arrangement wherein the reference surface is a continuous extension of the secondary sealing surface.<sup>4</sup>

In view of the foregoing, we will sustain the rejection of claims 1, 17 and 22 under 35 U.S.C. § 102(b) as being anticipated by Szymczak.

Turning to the rejection of claim 8 under 35 U.S.C. § 102(b) as being anticipated by Szymczak, the examiner has the initial burden of establishing a basis in fact and/or technical reasoning to **reasonably** support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. **See Ex parte Levy**, 17 USPQ2d 1461, 1463-64 (Bd. Pat. App. & Int. 1990). Here, we do not find the examiner has discharged that initial burden.

The answer states that

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<sup>4</sup> It is well settled that features not claimed may not be relied upon in support of patentability. **In re Self**, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

[w]hile the disclosure of Szymczak does not specifically discuss a "lever point"<sup>5</sup> and a "moment" thereabout, since the structure of the housing, connector and seal ring of Szymczak are the [sic] like those of the claimed present invention, the moment generated in the seal ring is considered to be an **inherent feature** of the system. . . . The portion 34 of the wellhead housing acts as a "lever point" which is in engagement with the portion 30 of the seal which the examiner views as the "lever contact point"<sup>5</sup> which is where the compressive forces are imposed by the wellhead housing and the wellhead connector. [Page 7, footnote added.]

We must point out, however, the "portion" 34 to which the examiner refers is a **clamping** shoulder or surface (see col. 3, lines 6 and 7) which is **directly opposed** by a similar **clamping** shoulder or surface on either the blowout preventer 16 or production tree 66, which clamping structure would prevent the surface 34 from being a lever point as the examiner suggests. Moreover, the structure of the housing, connector and seal ring of Szymczak are not "like" those of the appellant as the examiner states. As is evident from Fig. 4 of the appellant's drawings, the wellhead connector 21 (and ring seal surface

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<sup>5</sup> We understand the recitation of "lever point" and "lever contact point" in claim 8 to reference the claimed structure when considered in cross-section inasmuch as the support upon which the appellant's "lever" turns extends about the entire circumference of the wellhead when considering the claimed system as a whole.

Appeal No. 98-2150  
Application No. 08/539,926

15e) extends closer to the centerline 26 of the wellhead housing than any opposing structure on the wellhead housing, thus generating a moment in the secondary sealing ring 15. In Szymczak, however, the respective opposing structures extend the **same** distance from the centerline of the wellhead housing. This being the case, the examiner has not provided a reasonable basis for concluding that a moment is generated in Szymczak's seal ring. Inherency may not be established by probabilities or possibilities. **See In re Oelrich**, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) and **In re Rijckaert**, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

In light of the above, we will not sustain the rejection of claim 8 under 35 U.S.C. § 102(b) as being anticipated by Szymczak.

In summary:

The rejection of claims 1, 17 and 22 under 35 U.S.C. § 102(b) is affirmed.

The rejection of claim 8 under 35 U.S.C. § 102(b) is reversed.

Appeal No. 98-2150  
Application No. 08/539,926

Appeal No. 98-2150  
Application No. 08/539,926

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a).

***AFFIRMED-IN-PART***

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| IRWIN CHARLES COHEN         | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| JAMES M. MEISTER            | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
|                             | ) |                 |
|                             | ) |                 |
| JOHN P. McQUADE             | ) |                 |
| Administrative Patent Judge | ) |                 |

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Appeal No. 98-2150  
Application No. 08/539,926

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